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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,731	04/09/2001	Marc Alaia	46700-5004-12	8904
28977	7590	06/13/2005	EXAMINER	
MORGAN, LEWIS & BOCKIUS LLP			PATEL, JAGDISH	
1701 MARKET STREET			ART UNIT	
PHILADELPHIA, PA 19103-2921			PAPER NUMBER	
			3624	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,731

Applicant(s)

ALAIA ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 89,92,93,95-99,102,103,105-108,138-140,144-151 and 153-158 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 89, 92-93, 95-99, 102-103, 105-108, 138-140, 144-151 and 153-158 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This communication is in response to amendment filed 6/8/2004.

Response to Amendment

2. Claims 89, 99, 138, 151 have been amended per request.
3. Claims 89, 92-93, 95-99, 102-103, 105-108, 138-140, 144-151 and 153-158 are currently pending.

Response to Arguments

4. Rejection of claims 89, 92-93, 95-98, 138-140 and 144-150 under 35 U.S.C. 101 has been withdrawn.
5. Applicant's arguments with respect to rejection of aforementioned claims under 35 U.S.C. 103 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

6. Claims 89, 92-93, 95-99, 102-103, 105-108, 138-140, 144-151 and 153-158 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Exemplary claim 89 recites limitation "behind market bid"..

However, this term renders the claim indefinite since the term is indefinite because the specification does not clearly redefine the term. Terminology Used Inconsistent with Accepted

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Meaning Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term.

Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

The examiner has interpreted this term as bids which arrive late or towards the scheduled closing of the auction. The following analysis is accordingly based upon the examiner's interpretation of the term "behind market bid".

Claim Rejections - 35 USC § 103

7. Claims 89, 92-93, 95-97, 99, 102-103, 105-107, 138-140, 144-151, and 153, 155-158 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newsbyte and further in view of Officially taken notice.

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Claim 89: Newsbyte discloses a method to control overtime in an overtime auction (online auction - title), comprising:

(a) defining a first time interval ..during which bids are submitted to the auction for a first lot ("..between three and fourteen days including "the final ten minutes", assumed now on that this is 3 days), a second time interval (the auction is extended in "ten-minute increments", the second time interval amounts to 3 days plus 10 minutes (one increment)), and a first closing time..(3 days after the start of the auction), wherein the first closing time is defined as a specific scheduled closing time (closing time is initially defined as 3 days from the starting time, i.e. if the starting time is 12:00 AM Sunday then the scheduled closing time would be 12:00 AM Wednesday);

(b) determining whether at least one behind market bid for the first lot is received by a server ..during the first time interval, the at least one behind market bid greater than a market leading bid;

("If any bidding occurs in the final ten minutes.." this requires determining that at least one bid is received behind the market (i.e. late or towards the scheduled closing of the auction)

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(c)extending the first closing time using the second time interval in accordance with the determination made in step (b) (in the example earlier cited in step (a) the "initial" closing time of 3 days is extended by second time interval to 3 days and 10 minutes. Note that the first closing time is 12:00 AM Wednesday which now extended using the second time interval (i.e. 10 minutes) to 12:10 AM);

wherein the server and ..bidder participating in the auction are coupled over a communication network during the auction (Excite auction is "online" excite being a sponsor);

wherein the first closing time corresponds to an end of the first time interval if the first closing time is not extended in step (c) (first time interval is 3 days which is the first closing time), and ... corresponds to an end of the second time interval if first time interval is extended (auction is closed in 3 days plus 10 minutes if extended).

Official notice is taken that "buyer driven" auctions are old and well known wherein a buyer defines a lot or the item to be auctioned. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the Newsbyte concept of extending the first closing time using the second closing time which is disclosed for a "seller driven"

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auction to a "buyer driven" auction (wherein a buyer defines a lot to be auctioned and the buyer desires to buy the item(s) at the lowest price from a plurality of sellers).

It would have been obvious to one of ordinary skill in the art to have the lot defined by a buyer and combine with the teaching of the Newsbyte reference so as to allow the buyer or administrator of the auction to control various timing elements per the foregoing analysis so as to keep the auction running even beyond the scheduled closing time so long as bids which are lower or higher than the best bid previously received keep arriving since this would allow the buyer or seller of the lot of goods to receive most desired price from the bidders.

Claim 92. Second time interval varies during the auction (the auction is extended in 10 minute increments, however, at the discretion of the auctioneer this may be changed to any other time amount).

Claims 93, 95-97: (exemplary analysis) overtime extension is triggered if the submitted bid is better than a current best bid.. (any bidding occurring in the final ten minutes inherently considers various factors recited in the present claims. A person of skilled in the art would appreciate that a plurality of conditions are appropriate for triggering extension of the

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auction because the purpose of the auction is to optimize the administration of auction in consideration of time constraints and providing for maximum benefit to the sellers).

The Newsbyte fails to explicitly disclose various criteria for triggering the overtime extension stated in claims 94-97. It would have been an obvious matter of design choice to apply one or more condition related to the submitted bid (within a predetermined amount of another bid as an example per claim 95) or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine such knowledge with the relevant teachings of the cited reference.

All limitations of claims 99 and 102-107 have been analyzed as in corresponding method claims 89 and 92-97. Note that Newsbyte applies to on-line auction and therefore, computer readable medium is inherent in Newsbyte.

All limitations of claims 138-140 and 144-145 have been analyzed in claims 89, 92-93, 95-97 as discussed previously.

Per claim 146, the second time interval (3 days + 10 minutes) extends to a second closing time (start time plus (3 days + 10 minutes) instead of 3 days from the start) further comprises:

Defining a third time interval (third time interval = 3 days + (2 times) 10 minutes), a fourth time interval (fourth

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time interval = 3 days + (3 times) 10 minutes) a second overtime condition..(any bidding occurring in last ten minutes of any interval), the third time interval not being equal to the fourth ..(this is obvious from the above explanation);

Determining whether the second overtime condition occurs during the third time interval (the auction is extended in ten-minute increments in response to any bidding occurring in the final ten minutes);

Extending the second closing time by the fourth time interval in accordance with the second determination (the second closing time 3 days plus 10 minutes from the start of the auction is extended to further 10 minutes and so on).

Per claims 147-150 Newsbyte teaches all limitations of claim 147, 148 and 150. Note that first time interval is 3 days, second time interval is 10 minutes before scheduled closing and second time interval is 10 minute, which is extension time.

All limitations of claim 150 are analyzed as per claim 146.

Claim 151: all limitations have been analyzed in accordance with corresponding method claim 89. Note that because Newsbytes discloses an on-line (i.e. internet based) auction, machine-readable medium is inherent therein.

Claim 153. overtime occurs when an amount of the at least one behind market bid is within at least predetermined

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amount..of another bid (there is no tradeoff for the offerer to extend the auction if the new higher bid received is only numerically higher, which would not justify extending the auction due to cost of associated with extending the auction).

Claims 155, 157 and 158 have been analyzed per claims 151 and 147-149 as above.

Claim 156: wherein the overtime triggering interval equals the extension time interval (byte, final ten minutes is overtime triggering interval and ten minutes is extension time interval).

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571)272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

6/8/05